

Remarks

This communication is responsive to the Office Action of February 19, 2009. Reexamination and reconsideration of the claims is respectfully requested.

Status of Claims

Claims 23-26, 28-29, 31-32 are pending for examination.

Claims 1-22, 27, 30 were previously canceled.

Claims 23-26, 28, 31 and 32 are amended herein.

Claims 29 are cancelled herein.

Claims 23, 26, 28 are in independent form.

Summary of The Office Action

I. Claims 24-26, 28-29, and 31-32 were rejected under 35 U.S.C. 112, first paragraph as purportedly failing to comply with the enablement requirement.

II. Claims 26 and 31 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for purportedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

III. Claims 23-26, 28-29, and 31-32 were rejected under 35 U.S.C. 101 because the claimed invention is purportedly directed to non-statutory subject matter.

IV. Claims 23-26, 28-29, and 31-32 were rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Wolff, U.S. Pub. No. 2004/0143477 A1.

V. Claim 32 was rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Wolff in view of Lai, U.S. Pub. No. 2005/0044197 A1.

Argument

I. Claims 24-26, 28-29, and 31-32 were rejected under 35 U.S.C. 112, first paragraph as purportedly failing to comply with the enablement requirement.

The claims have been amended to address the rejection under 35 U.S.C. 112, first paragraph. Independent claims 23 and 26 have been amended to recite that a metaplan includes sets of planning criteria. Support for the amendments to claims 23 and 26 can be found, for example, in paragraphs [0036], [0055] –[0057] and Figure 6 of the specification. Claims 24, 28, and 31 have been amended to replace the word “establish” with the word “select” with respect to various planning criteria. Support for the amendment to claims 24, 28, and 31 can be found, for example, in paragraph [0036] of the specification. Applicant submits that the claims are enabled by the specification and the rejection should be withdrawn.

II. Claims 26 and 31 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for purportedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 26, the Examiner’s attention is drawn to paragraphs [0056] – [0057] in which structure corresponding to the recited means for producing a Web services project metaplan (i.e., first logic 610, Figure 6) and means for producing a Web services project plan refining the Web services project plan (i.e., second logic 630, Figure 6). Logic is defined in paragraph [0019] and includes many alternative structures. Applicant submits that claim 26 distinctly claims the subject matter that is regarded as the invention and the rejection of same should be withdrawn.

Claim 31 has been amended to clarify that any one of the recited sets is sufficient. Applicant submits that claim 31 distinctly claims the subject matter that is regarded as the invention and the rejection of same should be withdrawn.

III. Claims 23-26, 28-29, and 31-32 were rejected under 35 U.S.C. 101 because the claimed invention is purportedly directed to non-statutory subject matter.

Claims 23-25 were rejected under 35 U.S.C. 101 as being directed to a system in which no structure is recited. Claim 23 has been amended to recite, in part, a metaplan data store and a project plan data store. Data stores are statutory structural claim elements. Further, the definitions of computer-readable medium in paragraph [0017], logic in paragraph [0019] and software in paragraph [0022] have been amended so that claims will not be misinterpreted to include non-statutory subject matter. Claim 23 and its dependent claims 24-25 recite statutory subject matter and the rejection should be withdrawn.

Claim 26 was rejected under 35 U.S.C. 101 as being directed to a system that includes a means for element without corresponding structure in the specification. The Examiner's attention is drawn to paragraphs [0056] – [0057] in which structure corresponding to the recited means for producing a Web services project metaplan (i.e., first logic 610, Figure 6) and means for producing a Web services project plan refining the Web services project plan (i.e., second logic 630, Figure 6). Logic is defined in paragraph [0019] and includes many alternative structures. Further, claim 26 has been amended to recite a metaplan data store that stores sets of planning criteria in electronic form. Data stores are statutory structural claim elements. Claim 26 recites statutory subject matter and the rejection should be withdrawn.

Claims 28-29 and 31-32 were rejected under 35 U.S.C. 101 as being directed to a non-statutory method. Claim 28 has been amended to recite the step of accessing sets of planning criteria in a first memory of an electronic device and also the step of storing the Web services project plan in a second memory. Thus, claim 28 is tied to particular article, namely memory. Further, performance of the method of claim 28 transforms data. For example, the method accesses stored planning criteria, provides values for the criteria, and stores a plan produced by providing values for the planning criteria. Prior to performance of the method of claim 28, a Web services project plan is not stored in the second memory of the electronic device, while after performance of the method, a Web services project plan is stored in the memory. Thus the method of claim

28 transforms data. Further, claim 28 has been amended to recite a computer-readable medium having computer-executable instructions stored thereon for performing the method, which is statutory. Claim 28 and its dependent claims 31-32 recite statutory subject matter and the rejection should be withdrawn.

IV. Claims 23-26, 28-29, and 31-32 were rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Wolff, U.S. Pub. No. 2004/0143477 A1.

35 U.S.C. §103

To establish a *prima facie* case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

Here, there the claims are not obvious because Wolff fails to teach or fairly suggest a Web services project plan including several increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each increment.

Independent Claim 23

Claim 23 has been amended to recite, in part, a system that includes a second logic configured to produce a Web services project plan that includes a set of increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each increment. Support for the amendment to claim 23 can be found, for example, in paragraphs [0041] and [0048] of the specification.

Wolff fails to teach or suggest the system recited in claim 23. For example, Wolff fails to teach a Web services project plan including several increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each increment. The Office Action cites Wolff [0069] as teaching means for refining the project plan based on project evaluation. (Office Action, page 8, first full paragraph). However, Wolff merely describes identifying feedback information and providing the information to various predecessor activities so that the predecessor activities may be performed again. Re-performing activities is not the same thing as refining a plan. Thus Wolff fails to teach or suggest a Web services project plan including several increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each increment. A *prima facie* case of obviousness with respect to claim 23 has not been established. The rejection of claim 23 and its dependent claims 24-25 should be withdrawn.

Independent Claim 26

Claim 26 has been amended to recite similar elements to elements recited in independent claim 19 such as a Web services project plan including several increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each increment. These elements were discussed under claim 23 above. As established with respect to claim 23, Wolff fails to teach or suggest each and every element of claim 26. A *prima facie* obviousness rejection has not been established and the rejection should be reversed. Claim 26 should now be in condition for allowance.

Independent Claim 28

Claim 28 has been amended to recite similar elements to elements recited in independent claim 19 such as a Web services project plan including several increments corresponding to portions of an overall Web services project plan, where the Web services project plan includes a project evaluation and plan refinement after each

increment. These elements were discussed under claim 23 above. As established with respect to claim 23, Wolff fails to teach or suggest each and every element of claim 28. A *prima facie* obviousness rejection has not been established and the rejection should be reversed. Claim 28 and its dependent claims 31-32 should now be in condition for allowance.

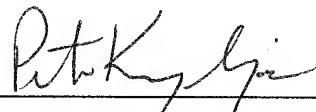
V. Claim 32 was rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Wolff in view of Lai, U.S. Pub. No. 2005/0044197 A1.

Claim 32 is a dependent claim. Since claim 28, from which claim 32 depends, has been shown to patentably distinguish over the references of record, the rejection of the dependent claim 32 should be withdrawn.

Conclusion

For the reasons set forth above, the claims are now in condition for allowance.
An early allowance of the claims is earnestly solicited.

Respectfully submitted,



Peter Kraguljac (Reg. No. 38,520)
Jennifer Nock Hinton (Reg. No. 47,653)

(216) 503-5500

Kraguljac & Kalnay, LLC
4700 Rockside Road
Summit One, Suite 510
Independence, OH 44131